UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,503	07/29/2003	David M. Mitteer	GRA01 P-418	6730

277 7590 03/14/2007

PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS, MI 49501

EXAMINER	
KRAUSE, JUSTIN MITCHELL	
ART UNIT	PAPER NUMBER
3682	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/629,503	MITTEER, DAVID M.	
	Examiner	Art Unit	
	Justin Krause	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15 and 24-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15,24-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the disclosure, as originally filed, for the limitation that the knob is "palm-sized and configured to receive a user's hand".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what size the limitation "palm-sized and configured to receive a user's hand" is bounded by. The size of a user's palm is relative, and there is no base of comparision for determining what "palm sized" is.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9, 24, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muramatsu et al. (US Patent 4,919,242) in view of Hiramoto et al (US Patent 5,697,477).

Muramatsu discloses a shift mechanism comprising:

-a base (6)

-a shift gate having a plurality of notches (7)

-a shift lever (1) mounted to the base

-a pawl (5) configured to move between an engaged and a disengaged position

-a button on the shift lever (4) operatively connected to the pawl

Muramatsu does not disclose a pneumatic mechanism providng a first resistance against movement of the pawl in a first direction and a second resistance against movement of a pawl in a second direction, the second resistance being greater than the first. Muramatsu does however disclose a spring, which provides equal resistance in both directions.

Hiramoto teaches a pneumatic mechanism providing a first resistance in a first direction (retraction), and a different, second resistance in a second direction (extension), the second resistance being greater than the first resistance (col 1, lines

55-63) for the purpose of obtaining satisfactory damping by coping with a change in the load by changing the damping force (col 2, lines 3-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Muramatsu and incorporate a pneumatic mechanism the for the desired purpose of obtaining satisfactory damping by coping with a change in the load by changing the damping force as taught by Hiramoto.

Regarding claim 2, Muramatsu discloses a linkiage (2) disposed in the shift lever, coupled to the pawl.

Regarding claim 3, the pawl is biased into the engaged position.

Regarding claim 4, the shift lever includes a knob (3) the button being positioned on the knob, the pneumatic mechanism includes a passageway (Hiramoto, 52) through which fluid passes, a moveable member (Hiramoto, 42) that selectively restricts the passageway depending upon the direction of movement of the button.

Regarding claim 5, the movable member is a resilent ring, the pneumatic mechanism includes an annular groove (Hiramoto, 40), the resilent ring disposed in the annular groove.

Regarding claim 6, the pneumatic mechanism includes a cylindrical chamber in the knob and a plunger (Hiramoto, 12), at least a first end portion of which is slidably disposed in the cylindrical chamber (Hiramoto, 46), the annular groove located adjacent the first end portion of the plunger.

Regarding claim 7, the plunger defines an axis along which the plunger moves, the chamber defines a chamber sidewall, the annular groove defines a base wall and opposing sidewalls (see fig 5), the resilient ring frictionally engaging the base wall of the groove and the chamber sidewall.

Regarding claim 8, the plunger includes a slot (52) extending axially from the base wall towards a second end portion to form the passageway.

Regarding claim 9, the resilient ring is an o-ring.

Regarding claim 26, as best understood, the shift mechanism of Muramatsu is palm-sized and configured to receive a user's hand.

Claims 10-15, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn et al (US Patent 5,494,141) in view of Hiramoto (US Patent 5,697,477).

Osborn discloses a shift mechanism comprising:

-a base (9)

-a shift lever (10) movably mounted to the base

-a shift knob (13) mounted to the shift lever, the shift knob having a cavity (the open area within the knob, see figure 2) defining a sidewall;

Osborn does not disclose a plunger having a first end portion movably disposed in the cavity, the first end portion including an annular groove defining a base, the first end portion having a passageway extending from the annular groove away from the first end portion;

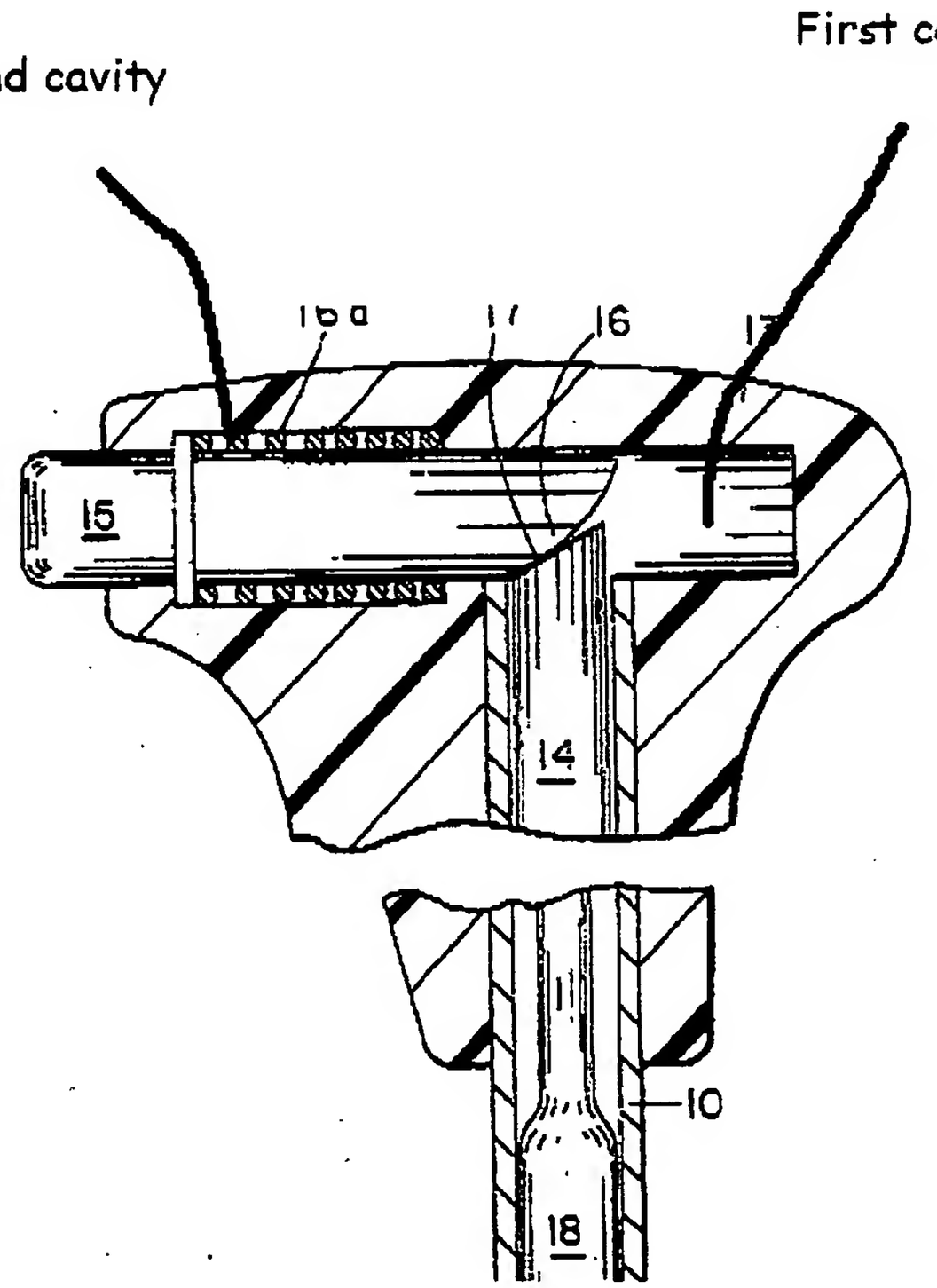
and a resilient ring in the annular groove, the resilient ring having an outer peripheral edge sealingly engaging the sidewall, and an inner edge engaging the base wall of the annular groove, the resilient ring configured to shift within the annular groove to close off the passageway upon movement of the plunger, but Osborn does teach a plunger, as broadly interpreted (16) which has a first end movably disposed in the cavity.

Hiramoto teaches a plunger (12) having a first end portion (see figure 5, the left side of the drawing is considered the "first end") movably disposed in the cavity, the first end portion including an annular groove (40) defining a base wall, the first end portion having a passageway (52) extending from the annular groove away from the first end portion; and a resilient ring (42) in the annular groove, the resilient ring having an outer peripheral edge sealingly engaging the sidewall, and an inner edge engaging the base wall of the annular groove for the purpose of obtaining satisfactory damping by coping with a change in the load by changing the damping force (col 2, lines 3-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plunger as taught by Hiramoto into the device of Osborn, the motivation would have been to obtain satisfactory damping by coping with a change in the load by changing the damping force.

Regarding claim 13, the cavity comprises a first cavity having a cylindrical shape defining a first diameter, the knob defining a second cylindrical cavity coaxial with the first cavity and defining a second diameter larger than the first diameter; the plunger

including a second cylindrical end portion (in Hiramoto, figure 5, the right side is considered the "second end portion") slidably disposed in the second cavity. (see figure below)



Regarding claim 14, the plunger includes a pair of spaced apart extensions extending generally parallel to the first end portion having an outer cylindrical surface poritions contiguous with the second end portion, wherein the first end portion is disposed between the extensions.

Regarding claim 15, the pawl release mechanism includes a shift lever (10) connected to the shift knob and an axially movable link (18) mounted in the shift lever, the second cavity defines an axis,

The second cylindrical end portion of the plunger includes a wedge surface (see Osborn fig 2) disposed non-orthogonal relative to the axis, configured to push the link axially along the shift lever.

Regarding claim 26, as best understood, the shift mechanism of Muramatsu is palm-sized and configured to receive a user's hand.

Response to Arguments

Applicant's arguments filed December 18, 2006 have been fully considered but they are not persuasive.

Applicant argues that the Hiramoto reference is non-analogous art. The examiner disagrees. Applicant cites *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992) which sets forth two criteria, 1) the art is from the same field of endeavor, regardless of the problem addressed, and 2) if the reference is from a different field of endeavor, whether it is still reasonably pertinent to the particular problems with which the inventor is involved. Using the second criteria, applicant concludes that Hiramoto is non-analagous because it is not reasonably pertinent to the same problem, as Hiramoto serves a specific purpose of "gradually increasing a frictional force between an inner periphery of the reduced diameter portion and the sealing member", however Hiramoto is concerned with solving the same problem as the applicant in a much broader sense than the

specific reason applicant provides, that is providing a slow, dampened movement in one direction and a fast, significantly less damped motion in the other direction for smooth operation (see Col 1, lines 25-54). This purpose of the disclosed structure is reasonably pertinent to the problem in which applicant is concerned with.

In response to applicant's argument that the object of the present invention is noise reduction, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues that Hiramoto discloses an air damper without size constraints whereas the shifter of the present invention contains considerable special constraints. Applicant's argument is founded on the inference that the size of Hiramoto is significantly large to prevent its incorporation into a shifter. The examiner finds no support in Hiramoto of any specific size that the device is, or must be. Additionally, applicant admits that claim 1 does not recite a particular size or location, and the examiner can find no reference in applicant's specification relating to the size of the present invention, and no claim of size with the exception of claim 26 which is considered as including new matter related to the undisclosed size of the device. The device of Hiramoto can be modified and incorporated into a shifter.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Krause whose telephone number is 571-272-3012. The examiner can normally be reached on Monday - Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMK
3/9/07
JMK

Thomas R. Hannon
Primary Examiner